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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,782	04/13/2004	Masayuki Negoro	032879-021	3199
21839	7590	11/06/2006	EXAMINER	
BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			GOLOBOY, JAMES C	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/822,782

Applicant(s)

NEGORO ET AL.

Examiner

James Goloboy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/25/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Chance (U.S. Pat. No. 4,006,274).

In column 1 lines 18-24 (the top structure in the equation), Chance discloses a triazine ester that meets the conditions of Claim 5 where  $X^1$ ,  $X^2$ , and  $X^3$  are  $NR^1$  ( $R^1 = H$ ) groups, and  $R^{11}$ ,  $R^{12}$ , and  $R^{13}$  all contain an ester bond.

3. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Beiersdorf AG (EP 1,055,421 A2).

In paragraph 21 (page 4), Beiersdorf AG discloses a compound meeting the conditions of Claims 5 and 6, where  $X^1$ ,  $X^2$ ,  $X^3$ ,  $X^{21}$ ,  $X^{22}$ , and  $X^{23}$  are  $NR^1$  ( $R^1 = H$ ) groups, two of the R groups in each compound have an ester bond, and  $a_{21}$ ,  $a_{22}$ , and  $a_{23}$  in Claim 6 are equal to 1.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chance in view of Emert (U.S. Pat. No. 5,498,809).

The discussion of Chance in paragraph 2 above is incorporated here by reference. Chance discloses a triazine ring-containing compound which meets the structural conditions of the compound recited in claims 1 ( $m = 3$ ), 2 (six-membered heterocyclic group), and 3. Chance does not disclose a lubricant composition comprising the compound.

In column 74 line 67, Emert discloses the use of N-substituted triazines, such as the compound of Chance, as amine-containing antioxidants additives in lubricant compositions. It would have been obvious to one of ordinary skill in the art to use the

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triazine of Chance in a lubricant composition, as taught by Emert, in order to prevent the deterioration of the base oil, as taught in column 70 lines 43-48 of Emert.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beiersdorf AG in view of Emert.

The discussion of Beiersdorf AG in paragraph 3 above is incorporated here by reference. Beiersdorf AG discloses a triazine ring-containing compound that meets the structural conditions of the compound recited in Claim 4. Beiersdorf AG does not disclose a lubricant composition comprising the compound.

In column 74 line 67, Emert discloses the use of N-substituted triazines, such as the compound of Beiersdorf AG, as amine-containing antioxidants additives in lubricant compositions. It would have been obvious to one of ordinary skill in the art to use the triazine of Beiersdorf AG in a lubricant composition, as taught by Emert, in order to prevent the deterioration of the base oil, as taught in column 70 lines 43-48 of Emert.

***Allowable Subject Matter***

8. Claims 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The nearest prior art compound is found in Heidenfelder (US PG Pub. No. 2003/0124158), paragraphs 179-193, but R groups discloses in the reference do not match those of Claims 7-9.

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### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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